REMARKS/ARGUMENTS

Reconsideration of the application is requested.

Claims 1-3, 5, 6, 8 and 10-17 are now in the applications. Claims 4 and 7 have been canceled and the subject matter thereof has been incorporated in claim 1. The dependency of claims 5 and 6 has been changed. Further, claims 8, 12, and 13 have been amended. Claims 14-17 have been added.

Claim 1 is now a combination of claims 1 + 4 + 7. In light of the indicated allowability of claim 7, claim 1 is now in condition for allowance.

Claim 2 now appears as claim 14 (dep. on claim 12) and claim 16 (dep. on claim 13).

Claim 3 now appears as claim 15 (dep. on claim 12) and claim 16 (dep. on claim 13).

Claims 12 and 13 were indicated as allowed. In response to the objection in the paragraph bridging pages 2 and 3 of the Office action, claims 12 and 13 have been amended by introducing first line indents for each of the paragraphs.

We now turn to the rejection of claim 8 under 35 U.S.C. § 101 and the Examiner's request for more information on page 5 of the Office action. Enclosed herewith is a copy of In re Dean, 130 USPQ 107 (CCPA 1961), which forms the basis for counsel's argument. Also enclosed are some pertinent pages from Robert Faber, *Landis on Mechanics of Patent Claim Drafting*, Third Edition, PLI (Practicing Law Institute), New York, 1990.

It is hoped that this information will clarify the issues surrounding the method claim and that the Examiner will now agree with counsel's assessment. If this is not the case, the Examiner is requested to telephone counsel so that the matter may be resolved.

We now turn to the art rejection, in which several claims have been rejected as being anticipated by Spix et al. (U.S. Patent No. 5,253,359) under 35 U.S.C. § 102(b).

The rejection of claims 1-4 is now moot, as the subject matter of claim 7 has been incorporated into claim 1.

The rejection of claim 8 is respectfully traversed. Spix et al. neither anticipates the invention nor renders it obvious.

The rejection of claim 8 turns on the issue of what exactly is claimed in claim 8. According to the Examiner, the preamble of claim 8 only "defines the environment in which the claimed invention is intended to occur or operate." This is incorrect. Instead, the preamble of claim 8 defines the environment that is required, the "combination" as it were. That environment is not an intended use, but it is a necessary component of the method. The method steps following the introductory preamble form a part of - and make sense only in combination with - the introductory words. What is indeed claimed is a sequence of method steps within an "error determination method in a program-controlled unit" and the method uses "scan chains" of the program-controlled unit. We once more request that the Examiner consider claim 8 as an In re Dean-type claim.

Upon reading the claim in light of the applicable law and properly interpreting the claim, the Examiner will surely agree that Spix et al. do not read on the detailed method.

The Examiner's comments have once more been considered. It is true the Spix et al. provides for an operator to control the system from the outside, such as n-stepping the master clock. As previously pointed out, however, the scan paths or Spix et al. are transfer gates. They do not belong to the "plurality of elements" that change their logic state during program

execution. When the system is stopped upon the detection of a given event, there is no such action as connecting the elements to scan chains and then to actually read out the scan chains and analyze the system. The scan paths of Spix et al. instead are transfer gates, which capture certain states of the clusters at certain clock periods. The registers are latched and, once they are frozen, there is no further reconnection of those latches of the register.

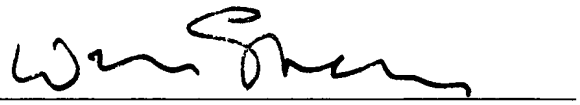
In claim 8, "freeze" the elements when a certain event is detected during program execution. The elements are connected to scan chains, and they are read out. This "freezing" and later indentifying of the errors lies at the core of the invention. Nothing in Spix et al. even remotely resembles this event sequence.

In summary, none of the prior art references, whether taken alone or in any combination, either show or suggest the features of claims 8, 12 and 13. These claims are, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent thereon, they are allowable as well.

With regard to the drawing objection, formal drawings are enclosed. The original figure has been identified as Fig. 1 and the newly added figure has been identified as Fig. 2.

In view of the foregoing, reconsideration and allowance of claims 1-3, 5, 6, 8 and 10-17 are solicited.

Respectfully submitted,



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